

REMARKS

The Office Action dated August 26, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bingle in view of Becker. The Office Action acknowledged that Bingle fails to disclose a translucent polycarbonate having a transparent coating thereon, and fails to disclose a transparent coating having a metallic gloss. Becker was cited for teaching a transparent coating having a metallic gloss for use on translucent plastics. Claims 2 and 3 depend from claim 1 and claim 5 depends from claim 4. The Applicants traverse the rejection and respectfully submit that claims 1-5 recite subject matter that is neither disclosed nor suggested by the cited references.

Bingle discloses a safety handle for a trunk of a vehicle. The handle 12 is preferably injection-molded from a resinous polymeric material such as polycarbonate/PBT or polycarbonate/ABS.

Becker discloses that properties of hybrid polymers or ceramers can be tailored to include transparent properties and can be used in automotive applications. See column 36, lines 16-36. Becker also discloses brush coating a mixture comprising polyureasilazane and diepoxide and further comprising ceramic filler onto a Type 304 stainless steel plate. The coated mixture was cured at 150°C for about 2 hours. A "silvery" metallic coating composition exhibiting excellent gloss and abrasion resistance was formed. See Column 64, lines 21-42.

With respect to independent claims 1 and 4, the Applicants submit that the combination of Bingle and Becker fails to disclose or suggest the claimed features of the

invention. Claim 1 recites "a main body made of synthetic resin; and a plating coat formed on the surface of the main body and having a metallic gloss; wherein the main body is molded from a translucent synthetic resin." Claim 4 recites "a lever main body molded from a translucent synthetic resin, and a translucent plating coat formed on the surface . . . whereby in a lighted environment, the translucent plating coat on the surface of the lever main body gives off a metallic gloss." As acknowledged in the Office Action, Bingle does not disclose a translucent polycarbonate having a transparent coating thereon nor does Bingle disclose a transparent coating having a metallic gloss. As discussed below, Becker fails to cure the deficiencies in Bingle as Becker also does not disclose or suggest "a main body made of synthetic resin; and a plating coat formed on the surface of the main body and having a metallic gloss; wherein the main body is molded from a translucent synthetic resin", as recited in claim 1. Becker also does not disclose or suggest a lever main body molded from a translucent synthetic resin", and "translucent plating coat formed on the surface ... whereby in a lighted environment, the translucent plating coat on the surface of the lever main body gives off a metallic gloss", as recited in claim 4.

The Applicants first submit that Becker does not disclose a plating coat on a surface of a synthetic resin main body. In contrast, Becker discloses in col. 64, lines 21-42 a coating applied to a stainless steel plate producing a "silvery" metallic coating composition. As set forth in the previous response dated July 23, 2004, the stainless steel plate is not comparable to the synthetic resin main body recited in claims 1 and 4.

Second, Becker discloses a hybrid polymer as a translucent body for forming articles having impact resistance and also as a coating. See col. 34, lines 20-49 of

Becker. The Office Action took the position that the coating disclosed in col. 64, lines 21-42 of Becker can be applied to translucent bodies in automotive applications as further disclosed in col. 34, lines 20-49. However, Becker does not disclose coating the hybrid polymer translucent body or hybrid polymer coating or any element disclosed in col. 34, lines 20-49 with the coating disclosed in col. 64, lines 21-42. Under U.S. Patent practice, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness unless the prior art also suggests a desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Here, Becker does not suggest the desirability of coating a hybrid polymer translucent body or coating a hybrid polymer coating. As such, Becker would not disclose or suggest coating a hybrid polymer translucent body or a hybrid polymer coating with the coating disclosed in col. 64, lines 21-42. Therefore, neither Becker nor the prior art suggest the desirability of coating the polycarbonate handle of Bingle.

Under U.S. Patent Practice, in order to establish a case of *prima facie* obviousness, there must be a reasonable expectation of success. Here, there is no reasonable expectation of successfully producing a metallic gloss on the translucent bodies or coatings formed from the hybrid polymer disclosed in Becker. In particular, Becker discloses forming a "silvery" coating by applying a mixture to stainless steel, which is a different material from a polymer. The silvery metallic coating composition disclosed in col. 64 of Becker is formed because the coating is applied to stainless steel. There is no disclosure or suggestion in Becker that applying the same coating to a polycarbonate handle of Bingle would produce the same result. As such, the resulting "silvery" appearance produced by coating stainless steel does not guarantee that the

same result will occur by coating the hybrid polymer disclosed in Becker. Thus, the Applicants submit that there is no reasonable expectation that the hybrid polymer disclosed in Becker, if coated with the coating mixture disclosed in col. 64, lines 21-42, would give off a metallic gloss. Therefore, there is no reasonable expectation of success that coating the polycarbonate handle of Bingle would cause the handle to have a “silvery” appearance or give off a metallic gloss.

Furthermore, it is known in the art that polymers dissolve in acetone, which is a solvent. The coating disclosed in Becker includes acetone. Therefore, coating the hybrid polymer with the coating disclosed in Becker may result in chemical degradation of the hybrid polymer.

The Applicants submit that there is no disclosure in Becker linking the coating disclosed in col. 64 to the hybrid polymer disclosed in col. 34. As such, the Applicants submit that combining disparate properties without a motivation or expectation of success does not establish *prima facie* obviousness. Accordingly, the Applicants submit that Becker does not disclose a plating coat formed on the surface of a main body made of synthetic resin and having a metallic gloss as recited in claims 1 and 4.

The Applicants note that in paragraph Response to Arguments Section, the Office Action stated that, even though the object of Bingle et al. is to improve the recognition of the handle by users in the darkened environment, “nothing in Bingle et al. precludes the handle from having a metallic gloss in a lighted environment. It is general knowledge in the art that automotive handles include metal handles that inherently have a metallic gloss and modifying the handle of Bingle et al. to have a metallic gloss in the lighted environment, without specific evidence of undesirability, could be acceptable to

one of ordinary skill in the art". (See page 4 of the Office Action.) The Applicants again submit that the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills at 682 and MPEP § 2143.01.

Further, under U.S. patent practice, the standard for obviousness is what the prior art teaches or suggests. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01. The Office Action's motivation for modifying Bingle because "nothing in Bingle et al. precludes the handle from having a metallic gloss in a lighted environment", is not the standard by which obviousness is determined. The polycarbonate handle of Bingle does not have a metallic gloss and Becker fails to disclose or suggest coating a main body made of synthetic resin so that it could have a metallic gloss. Accordingly, the combination of Bingle and Becker does not disclose or suggest a polycarbonate handle having a metallic gloss in a lighted environment as recited in the claims.

Also, with respect to claims 1 and 4, the Applicants submit that the combination of Bingle and Becker fails to disclose or suggest other claimed features of the invention. Claims 1 and 4 recite "whereby, in a lighted environment, the plating coat on the surface of the main body gives off a metallic gloss". The Office Action acknowledged that Bingle fails to disclose or suggest this claimed feature of the invention. The Applicants submit that Bingle does not disclose or suggest how the safety release assembly 10 can

operate in a lighted environment, or when the deck lid 16 is open. Namely, in Bingle, it is not necessary to make the safety release assembly 10 constructed so that it is easily recognized visually in a lighted environment, such as when the lid is open because Bingle is directed exclusively to a handle in a closed dark trunk space and to a situation where a person (mainly a small child) is accidentally trapped within the trunk space 18 of a vehicle. The object of Bingle is to help the trapped person easily and swiftly find a safety release assembly 10 in a dark environment. Thus, Bingle lacks a teaching or suggestion that would give one skilled in the art the motivation to consider how to make the system appeal to, and be recognized by, users in a lighted environment. As such, the Applicants submit that the prior art of Bingle does not disclose or suggest its own modification in the manner suggested in the Office Action, and therefore, the desirability of the claimed invention.

Becker also fails to cure the deficiencies in Bingle with respect to claims 1 and 4 as Becker does not disclose or suggest, "whereby in a lighted environment, the plating coat on the surface of the main body gives off a metallic gloss." Further, as discussed above, there is no disclosure or suggestion that applying the coating brushed onto the stainless steel plate of Becker as a coating on the polycarbonate safety release assembly in the dark environment of Bingle would allow the safety release assembly in Bingle to give off a metallic gloss as recited in claims 1 and 4. Therefore, the combination of Bingle and Becker fails to disclose or suggest the features of the invention as recited in claim 4.

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aikens in view of Bingle and further in view of Becker. Aikens was cited for

disclosing many of the claimed elements of the invention with the exception of an operating knob made from a translucent resin and having a translucent plating coat formed on the surface of the knob main body. Bingle and Becker were cited for curing this deficiency. Claim 7 depends from claim 6. The Applicants submit that claims 6 and 7 recite subject matter that is neither disclosed nor suggested by the cited references.

Aikens discloses a combination passenger reading light and air ventilator. A socket assembly 50 includes an electrically conductive mounting member 52, which includes a first cylindrical portion 54 adapted to engage the base of an electric light bulb. The bezel element 100 is removably secured to, and mostly within, ball housing 12. The bezel element 100 includes a first portion 102 insertable through a front opening 28 into the inner chamber 30 of ball housing 12. The bezel element first portion 102 is formed of a resilient material such as a synthetic polymeric material.

Claim 6 recites a knob main body molded from a translucent synthetic resin, and a translucent plating coat formed on the surface of the knob main body. . . whereby, in a lighted environment, the translucent plating coat on the surface of the knob main body gives off a metallic gloss. As acknowledged by the Office Action, Aikens and Bingle fail to disclose or suggest this feature. As discussed above, with respect to claims 1 and 4, the Applicants submit that Becker does not disclose or suggest coating a polymeric material, and therefore, cannot teach coating the polycarbonate member of Bingle. Therefore the combination of Aikens, Bingle and Becker do not disclose or suggest a knob main body molded from a translucent synthetic resin, and a translucent plating coat formed on the surface of the knob main body. . . whereby, in a lighted environment,

the translucent plating coat on the surface of the knob main body gives off a metallic gloss as recited in claim 6.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

The Applicants submit that as neither the combinations of Bingle and Becker, and Aikens, Bingle, and Becker disclose or suggest each and every feature of the claimed invention, the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 1-7 under 35 U.S.C. § 103.

Claims 2 and 3 depend from claim 1, claim 5 depends from claim 4, and claim 7 depends from claim 6. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 1, 4 and 6. Accordingly, the Applicants respectfully request allowance of claims 1-7 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107348-00209.**

Respectfully submitted,



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